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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,741	11/28/2001	Thomas Blattner	A03195	8342
2413I	7590	09/22/2004	EXAMINER	
LERNER AND GREENBERG, PA			HENDERSON, MARK T	
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HOLLYWOOD, FL 33022-2480			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/994,741	BLATTNER ET AL. <i>CH</i>
	Examiner	Art Unit
	Mark T Henderson	3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 August 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 10-20 is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Continued Prosecution Application***

1. The request filed on August 23, 2004 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/994,741 is acceptable and a RCE has been established. An action on the RCE follows.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Mann et al (4,351,371).

Mann discloses in Fig. 1, a process for binding brochures comprising: inserting the binding element (14) into a plurality of superposed sheet like material (11); and forming the single binding element (as seen in Fig. 1 at spindle (12)) immediately before inserting step to eliminate pre-formed binding element (Col. 3, lines 41-67 and Col. 4, lines 18-28); tailoring the binding element to complement the perforations (Col. 3, lines 55-65); wherein the single element corresponds to a width of the brochure (using a measuring instrument, Col. 3, lines 55-63); and forming a plurality of loops in the binding element in a row that extends across a width of the brochure and inserting the loops into the perforations at the same time (seen in Fig. 1).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaborn et al (4,047,544) in view of November.

Seaborn et al discloses in Fig. 1-4, a process for binding brochures comprising: inserting the binding element (W) into a plurality of superposed sheet like material; and forming the binding element (as seen in Fig. 1) immediately before inserting step to eliminate pre-formed binding element (Col. 7, lines 55-60); and forming a plurality of crimps, loop by loop, with a single die (32, which is on wire assembly 60 as seen in Fig. 8-11).

However, Seaborn et al does not disclose: inserting the binding element into perforations along an edge of sheets, wherein the binding element is tailored and complemented to the perforations.

November discloses in Fig. 4-6, a process wherein the crimp and loop binding element is tailored and complemented to the perforations (2) along an edge of superposed sheets (3 and 4).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Seaborn et al's brochure producing process to include a process for tailoring binding elements to fit inside perforations of sheets as taught by November for the purpose of forming a bound notebook.

4. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seaborn et al in view of November and further in view of Pigna et al (3,854,158).

Seaborn et al as modified by November discloses a process for producing brochures comprising all the elements as claimed in Claim 1, and as set forth above. However, November does not disclose: determining at least one production parameter with an electronic device, wherein the parameter consist of brochure thickness, wire diameter, wire length, or perforation spacing.

Pigna et al discloses in Fig. 1 and in Col. 3, lines 1-21, wherein an electronic sensing device (4) counts the wire loops (2) passing through a feeder means, and when the programmed loop count is reached, a cutting means (6) separates the looped wire from the remainder (3) of the strip, whereby the looped wire length need for the binding is determined.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Seaborn et al's and November's brochure producing process to include an electronic device to determine the appropriate wire length need as taught by Pigna et al

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for the purpose of avoiding the process of purchasing previously cut binder wire elements which can give rise to high costs.

***Allowable Subject Matter***

5. Claims 10-20 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or fairly teaches a process for producing brochures comprising determining a thickness of a brochure to be produced and storing the thickness in an electronic device; producing a binding element corresponding to the thickness; feeding the wire from a spool; bending wire into a flat, multiple loop binding element; cutting binding element and conveying it to an insertion device; supplying sheet like material to the insertion device, wherein the material has perforations; inserting the binding element into the perforations; bending the binding element into a ring-like binding; and including all of the other limitations in the independent claims.

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***Response to Arguments***

7. Applicant's arguments filed on January 12, 2004 have been fully considered but they are not persuasive.

In regards to applicant's argument that the prior art does not disclose wherein the binding element is formed immediately before being inserted into perforations in order to eliminate pre-formed binding elements supplies, the examiner submits that Mann et al as well as Seaborn et al disclose a process wherein a binding element is formed immediately before it is inserted in a brochures perforations. Note, with each prior art, there does exist an initial wire supply, however it is not "pre-formed" to that of a coil supply. Therefore, a "pre-formed" binding element (which is the coiled wire) does not exist. Applicant must go into further detail.

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### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

September 17, 2004



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